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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-------------------------|-------------|----------------------|---------------------|------------------|
| 10/578,137 | 05/03/2006 | Hirotaka Minami | P71250US0 | 5226 |
| 136 | 7590 | 10/07/2009 | EXAMINER | |
| JACOBSON HOLMAN PLLC | | | NUTTER, NATHAN M | |
| 400 SEVENTH STREET N.W. | | | | |
| SUITE 600 | | | ART UNIT | PAPER NUMBER |
| WASHINGTON, DC 20004 | | | 1796 | |
| | | | | |
| | | | MAIL DATE | DELIVERY MODE |
| | | | 10/07/2009 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/578,137 | MINAMI ET AL. | |
| | Examiner | Art Unit | |
| | Nathan M. Nutter | 1796 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 09 January 2009 and 14 April 2009.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 2 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 2 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ . | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Response to Amendment

In response to the amendment filed 9 January 2009 and the Substitute Specification filed 14 April 2009, the following is placed in effect.

The objection to the disclosure is hereby expressly withdrawn in view of the acceptable Substitute Specification and the statement under Rule 125.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Yamanaka et al (US 5,314,941).

Note column 1 (lines 11-15), column 2 (line 54) to column 3 (line 40), column 4 (lines 35-46), the paragraph bridging column 4 to column 5, column 5 (lines 21-43) and Comparative Example 5 at column 6.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Kushida et al (US 5,344,864).

Note the Abstract, column 1 (lines 7-25), at Table 1 the use of ChemigumTM, column 4 (lines 12-54), column 5 (lines 28-34), and the many Examples.

Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Oshima et al (US 5,484,844).

Note column 1 (lines 7-11), column 3 (lines 33-59), column 4 (lines 8-56), column 5 (lines 7-37 and 50-59).

Response to Arguments

Applicant's arguments filed 9 January 2009 have been fully considered but they are not persuasive.

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Yamanaka et al (US 5,314,941), the reference teaches the identical constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant. Note *In re Fitzgerald et al* 619 F. 2d 67, 70, 205 USPQ 594, 596 (CCPA 1980). Note MPEP § 2112-2112.02. Further, it is pointed out that applicants' claims do not exclude other components, even in large amounts. Since the claims are drawn to a composition, the intended use as an "adhesive...for bonding" fails to elevate the claims to the level of patentability. Applicants have failed to show the reference composition to not possess the adhesive characteristics ascribed to the recitation "for bonding."

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Kushida et al (US 5,344,864), the reference teaches the identical

constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant.

With regard to the rejection of claims 1 and 2 under 35 U.S.C. 102(b) as being clearly anticipated by Oshima et al (US 5,484,844), the reference teaches the identical constituents in identical compositional limitations as set out herein. The reference shows the production of the blend, as recited. When a reference discloses all of the limitations of a claim except a property or function, and the Examiner is unable to determine whether or not the reference inherently possesses properties that anticipate or render obvious the claimed invention, basis exists for shifting the burden of proof to applicant.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/
Primary Examiner, Art Unit 1796

nmm

6 October 2009